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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,803	09/27/2001	Jay Short	DIVER1130-8	3294

20985 7590 05/20/2003
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EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,803

Applicant(s)

SHORT ET AL.

Examiner

David J. Steadman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-92 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

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DETAILED ACTION

Application Status

- [1]** Claims 1-92 are pending in the application.
- [2]** Applicant's amendment to the specification in Paper No. 8, filed April 10, 2002 is acknowledged.
- [3]** It is noted that claim 64 is drawn to a purified polypeptide of claim 1. However, claim 1 is drawn to an isolated nucleic acid. It is further noted that claims 86 and 87 are drawn to enzyme preparations comprising a polypeptide of claim 17 or 25. However, claim 17 is drawn to a nucleic acid. In the interest of advancing prosecution, claims 64, 86, and 87 have been grouped with claims drawn to a purified polypeptide (Group II). It is suggested that applicant correct claim dependency.

Election/Restrictions

- [4]** Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I.** Claim(s) 1-23, 40, 41, and 67-85, drawn to an isolated nucleic acid, a method of producing a polypeptide, and a probe, classified in class 435, subclass 227.
 - II.** Claim(s) 24-35, 64, 86, and 87, drawn to a purified polypeptide and an enzyme preparation, classified in class 435, subclass 227.
 - III.** Claim(s) 36-39, drawn to a purified antibody, classified in class 530, subclass 387.9.
 - IV.** Claim(s) 42-55, drawn to a method of generating a variant, classified in class 435, subclass 440.
 - V.** Claim(s) 56-60, drawn to a computer readable medium and a computer system, classified in class 702, subclass 19.
 - VI.** Claim(s) 61 and 62, drawn to a method for comparing nucleic acid or polypeptide sequences, classified in class 435, subclass 6.
 - VII.** Claim(s) 63, drawn to a method for identifying a feature in a sequence, classified in class 435, subclass 6.

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VIII. Claim(s) 65, drawn to a method for catalyzing the hydrolysis of an amide, classified in class 435, subclass 136.

IX. Claim(s) 66, drawn to an assay for identifying functional polypeptide fragments or variants, classified in class 435, subclass 18.

X. Claim(s) 88-92, drawn to a method for modifying small molecules, classified in class 435, subclass 18.

[5] The inventions are distinct, each from the other because:

[6] The polynucleotide of Group I, the polypeptide of Group II, the antibody of Group III, and the computer system of Group V each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The polynucleotide of Group I has other utility besides encoding polypeptides such as a hybridization probe, the polypeptide of Group II can be made by another method such as purification from the natural source or chemical synthesis, the antibody of Group III can be made from a protein other than the protein of Group II, such as a protein produced by purification from the natural source or by chemical synthesis, and the computer system of Group V can be used to store data other than the sequence of SEQ ID NO:1 or SEQ ID NO:2.

[7] The polynucleotide of Group I and the method(s) of Group(s) IV, VI, and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotide of Group I can be used for protein expression.

[8] The polynucleotide of Group I is unrelated to the method(s) of Groups VIII-X as it is neither used nor made by the method(s) of Groups VIII-X.

[9] The polypeptide of Group II is unrelated to the method(s) of Group IV as it is neither used nor made by the method(s) of Group IV.

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[10] The polypeptide of Group II and the method(s) of Group(s) VI-X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group II can be used as an antigen for the production of antibodies.

[11] The antibody of Group III is unrelated to the method(s) of Groups IV and VI-X as it is neither used nor made by the method(s) of Groups VI and VI-X.

[12] The computer system of Group V is unrelated to the method(s) of Groups IV and VIII-X as it is neither used nor made by the method(s) of Groups IV and VIII-X.

[13] The computer system of Group V and the method(s) of Group(s) VI and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the sequences of SEQ ID NO:1 and 2 can be compared by eye and the computer system can be used as an entertainment console for playing games.

[14] The methods of Groups IV and VI-X are independent as they comprise different steps, utilize different products, and yield different results.

[15] MPEP § 803 sets forth two criteria for restricting between patentably distinct inventions – 1) the inventions must be independent or distinct and 2) there must be a serious burden on the examiner. MPEP § 803 states, "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02". Because the inventions of Groups I-X are distinct for the reasons given above and each of the inventions requires a separate patent and non-patent literature and sequence search, restriction for examination purposes is proper.

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[16] Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

[17] Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Thursday from 6:30 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.
Patent Examiner
Art Unit 1652

5/15/03

